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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/579,630

JUL 09 2007

Filing Date: May 26, 2000

GROUP 3700

Appellant(s): MCKINNON, ROBERT

Geoffrey Mantooth (Reg. No. 32,042)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 22, 2006 appealing from the Office action mailed May 8, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,921,449	HAUFFE et al.	11-1975
5,564,586	GOODWIN	10-1996
4,726,490	BONNEMA et al.	02-1988
5,755,350	MARTHALER	05-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 5, 6, 13, 18, 19, 25, 39, 40, 59, 60, 62, 69, 72, 74 and 75 have been rejected under 35 U.S.C. 102(b) as being anticipated by Hauffe et al. (U.S. 3,921,449). Hauffe et al. teaches a lid 31, with recesses shown at number "31" in figure 2.

(b) Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586). Hauffe et al. teaches a lid 31, with recesses shown at number "31" in figure 2. Hauffe et al. does not teach that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses. Goodwin teaches that it is known to provide a lid with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses (see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses, as taught by Goodwin, in order to increase the strength of the lid.

(c) Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(d) Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(e) Claims 20-24, 26-35, 61 and 63-65 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449). Hauffe et al. discloses the claimed invention except for the triangular shaped recess. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with a recess having a triangular cross section, in order to give the article a more decorative appearance.

(f) Claims 66-68, 70, 71 and 73 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449). Hauffe et al. discloses the claimed invention except for the thickness of the article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the thickness being at least 1.5 inches or no greater than two-thirds of the member thickness, since it has been held that “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

(g) Claims 5, 6, 13, 18-35, 39, 40 and 59-75 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350). Hauffe et al. teaches a molded plastic lid 31. Hauffe et al. does not teach that the lid could be compression molded.

Marthaler teaches that injection molding, blow molding, thermo molding and compression molding are “conventional manufacturing processes” (col. 3 lines 22-26). Marthaler also teaches that it is well known to mold container components using one of these “conventional manufacturing processes”, such as compression molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. made by compression molding, as taught by Marthaler, since it is considered a well known, conventional manufacturing process.

Regarding claims 20-24, 26-35, 61 and 63-65, Hauffe et al. discloses the claimed invention except for the triangular shaped recess. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with a recess having a triangular cross section, in order to give the article a more decorative appearance.

Regarding claims 66-68, 70, 71 and 73, Hauffe et al. also does not teach the thickness of the article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Hauffe et al. with the thickness being at least 1.5 inches or no greater than two-thirds of the member thickness, since it has been held that “where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

(h) Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350). Hauffe et al. teaches a lid 31, with recesses shown at number “31” in figure 2. Hauffe et al. does not teach that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses and that the lid is compression molded. Goodwin teaches that it is known to provide a lid with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses (see figure 2). It would have been obvious to one having ordinary skill

in the art at the time the invention was made to provide the lid of Hauffe et al. with smaller recesses such that the area of the lower surface is greater than the total area surrounded by the outer edges of the recesses, as taught by Goodwin, in order to increase the strength of the lid.

Marthaler teaches that injection molding, blow molding, thermo molding and compression molding are “conventional manufacturing processes” (col. 3 lines 22-26). Marthaler also teaches that it is well known to mold container components using one of these “conventional manufacturing processes”, such as compression molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Hauffe et al. made by compression molding, as taught by Marthaler, since it is considered a well known, conventional manufacturing process.

(i) Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490). Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(j) Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350), as applied to claim 5 above, and further in view of Bonnema et al. (U.S. 4,726,490). The modified device of Hauffe et al. discloses the claimed invention except for the wedges. Bonnema et al. teach that it is known to provide a lid with wedges (see elements 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made

to provide the modified lid of Hauffe et al. having wedges, as taught by Bonnema et al., in order to provide additional means with which the lid may be secured to the container.

(10) Response to Argument

(a) Claims 5, 6, 13, 18, 19, 25, 39, 40, 59, 60, 62, 69, 72, 74 and 75 have been rejected under 35 U.S.C. 102(b) as being anticipated by Hauffe et al. (U.S. 3,921,449)

(1) *The claims set forth that the lid can withstand a load of at least 8000 pounds.*

Appellant argues that Hauffe does not teach that the lid is capable of withstanding a load of at least 8000 pounds. It is the examiner's position that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (*Hewlett Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

In addition, the limitation that the lid is capable of withstanding a force of at least 8000 pounds is not supported by the claimed structure. The type of plastic and dimensions of the lid are necessary components to properly support the strength limitation. These necessary components are not set forth in the claim.

(2) *The claims set forth that the lid is compression molded.*

Appellant argues that Hauffe does not teach that the lid is compression molded. The limitation regarding the compression molding of the lid is a process limitation within a product claim. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a

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different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Regarding claims 59-75, the limitation that the plastic is compressed is met by Hauffe because all injection molding techniques require some compression of the material to give the product the desired shape. A compressed plastic does not require that the article was formed by compression molding methods, most molding techniques use some form of compression forces to achieve the desired shape.

(3) *The claims set forth that the lengths of the elongated edges of the recesses are greater than one half of the "given dimension" of the member.*

Since the "given dimension" of the member has not been defined, the recesses of Hauffe meet this limitation. The "given dimension" of the member is not limited to the overall length of the member, and could be any length equal to or less than the overall length of the member.

(b) Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586).

(1) *Motivation for combining Hauffe and Goodwin.*

The motivation to reduce the area of the recesses is found within the level of ordinary skill in the art. Increasing the areas of the lid with a greater thickness increases the strength of the lid, since more material is provided in the lid. It is well known in the container art that adding recesses to a solid article can increase the strength of the article, it is also well known that adding too many recesses to an article could reduce the strength of the article. Through routine experimentation, one of ordinary skill in the art can determine the desirable ratio of recesses to surface area. It is this general knowledge that is used as motivation to modify the primary reference of Hauffe.

(c) Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490).

The issues regarding claim 2 have been addressed above.

(d) Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Bonnema et al. (U.S. 4,726,490).

The issues regarding claim 7 have been addressed above.

(e) Claims 20-24, 26-35, 61 and 63-65 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449).

Regarding the shape of the recesses, it is well known in the container art to add recesses to solid structures for a variety of purposes. For example, recesses can be provided to improve traction, to allow for easier gripping by machine or by hand, to increase the strength, to reduce material and to enhance curing. It is also within the general knowledge of one of ordinary skill in the art that recesses may be provided in a variety of sizes and shapes. The shape of a recess may aid in distinguishing the article from that of a competitor or to distinguish the article from a similar articles having different strengths. These motivations are commonly known and for these reasons it is the examiner's position that it is obvious to alter the size and/or shape of recesses in such an article.

(f) Claims 66-68, 70, 71 and 73 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449).

In response to applicant's argument that Hauffe does not mention plastic curing, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of

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the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

(g) Claims 5, 6, 13, 18-35, 39, 40 and 59-75 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350).

Regarding the Marthaler reference, although appellant believes that compression molding the Marthaler article would not be practical, does not change the fact that Marthaler discloses that it was known to do so.

(h) Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350).

The issues regarding claims 1, 3, 4, 9, 12, 15-17, 37 and 58 have been addressed above.

(i) Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Goodwin (U.S. 5,564,586) and Marthaler (U.S. 5,755,350), as applied to claim 1 above, and further in view of Bonnema et al. (U.S. 4,726,490).

The issues regarding claim 2 have been addressed above.

(j) Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Hauffe et al. (U.S. 3,921,449) in view of Marthaler (U.S. 5,755,350), as applied to claim 5 above, and further in view of Bonnema et al. (U.S. 4,726,490).

The issues regarding claim 7 have been addressed above.

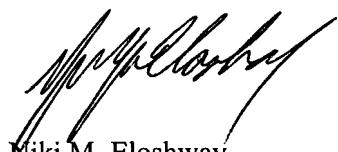
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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Niki M. Eloshtay

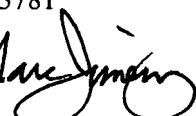


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